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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,765	01/16/2004	Nandakumar Vaidyanathan	59656-010100	8352
33717	7590	04/21/2005		
GREENBERG TRAUIG LLP 2450 COLORADO AVENUE, SUITE 400E SANTA MONICA, CA 90404				
EXAMINER NOLAN JR, CHARLES H				
ART UNIT		PAPER NUMBER		
2854				

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,765

Applicant(s)

VAIDYANATHAN ET AL.

Examiner

Charles H. Nolan, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 and 31-45 is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,3-6,9-13,17,19-27,30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Engl et al. (5,109,240).

With respect to Claim 1, Engl teaches the conductive element 33 in figure 3 which is addressable by a memory and mapped to at least one portion of a digital image in figure 2 and column 3, lines 30-45 and the conductive element being switchable between an ink attracting and not ink attracting state in column 5, lines 7-12. With respect to Claim 3, Engl teaches the semiconductor memory in column 3, lines 20-30. With respect to Claim 4, Engl teaches the digital signal to drive the printing element in figure 2. With respect to Claim 5, Engl teaches the printing elements are located on a printing drum 3 in figures 1 and 1a. With respect to Claim 6, Engl teaches that the printing elements may be a flat printing plate in figure 2 and column 3, lines 24-25. With respect to Claim 9, it is noted that the combination of the capacitor 15(see figure 2) or inductor 33 with the transistor 16 or 30 form a memory location as broadly recited in claim 9. With respect to Claim 10, Engl teaches the image is divided into smaller portions (domains) in column 5, lines 7-12 and his claim 4. With respect to Claims 11-13, Engl teaches the memory 8 coupled to a flexible circuit and the additional circuitry in column 4, lines 24-

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30 and the capability to conform to a rectangular surface W in figure 2 and the cylindrical surface 3 in figure 1a. With respect to Claim 17, Engl teaches the addressing step in column 2, lines 32-37 and the digitally decomposing step in column 2, lines 25-30. With respect to Claims 19 and 21, Engl teaches a flexible circuit 6 in column 3, lines 16-20 and an inflexible circuit (at least part of the circuit) 8 in figure 1a. With respect to Claims 22-23, Engl teaches a method of non-lithographic electrostatic attraction using semiconductor based memory devices without the use of lasers, photoconductor drums, printing plates or other charge imparting devices in column 3, lines 30-39 and column 4, lines 1-16 and figure 1a. With respect to Claim 24, Engl teaches the permanent charge to attract the charge ink until reset by the digital signal (computer) in column 2, lines 25-35. With respect to Claims 25-26, it is noted that the printer of Engl is capable of printing subtractive or additive based on Engl's teaching of "publisher's office" in column 1, lines 52-53. With respect to Claim 27, Engl teaches the printing on a printable surface (paper web) W and column 3, lines 9-10 and in figure 1a. With respect to Claim 30, Engl teaches the providing step in figure 2, the mapping step in column 2, lines 25-35 and the assigning step in 40-49.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 22,27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance for example, claim 22 recites the broad recitation charge imparting devices, and the claim also recites scorotons and or corotrons which is the narrower statement of the range/limitation. In the present instance for example, claim 27 recites the broad recitation media, and the claim also recites paper or plastics which is the narrower statement of the range/limitation. In the present instance for example, claim 27 recites the broad recitation printable surface, and the claim also recites "paper or cardboard..." which is the narrower statement of the range/limitation.

Claim Objections

6. Claims 21 and 45 are objected to because of the following informalities: Claim 21 is a substantial duplicate of Claim 19. Claim 45 depends on itself. Appropriate correction is required.

Allowable Subject Matter

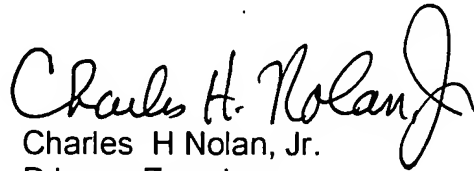
7. Claims 29,31-45 are allowed provided the formal matter in paragraph 6 hereinabove is addressed.

8. Claims 2,7-8,14-16,18,28-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H. Nolan, Jr. whose telephone number is 571-272-2171. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charles H Nolan, Jr.
Primary Examiner
Art Unit 2854

CHN